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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In the Application of:

EDSAL MANUFACTURING COMPANY

Application No. 10/823,198

For: **Cargo Rack**

Filing Date: April 13, 2004

Art Unit 3634
Sarah L. Purol
Patent Examiner

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Request for Reconsideration of Restriction Requirement and Express Election

This Response is in regard to the office action dated September 29, 2006 for a restriction requirement. Applicant respectfully traverses the restriction requirement and makes an express election, as required by 37 CFR 1.143. Please charge any additional payments and credit overpayments to Deposit Account No. 01-1154.

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1. Comments Regarding Inventions I and II related as process and apparatus for its practice

The Examiner has found Inventions I and II to be distinct based on their relationship as process and apparatus for its practice under MPEP § 806.05(e). [Office Action p. 2]. One of the advantages of the apparatus is its ability to be easily assembled and disassembled, as embodied in the method claims, due to the removable associations of the posts with the beams and the beams with the shelves. Thus Inventions I and II are indeed related as process and apparatus for its practice; but the product cannot be assembled using a *materially* different process as required to support a restriction requirement.

The process claims are directed to orientating, aligning and inserting different structural elements of the framework that are expressly contained in the apparatus claims. Each structural element in the process claims has antecedent basis in the apparatus claims, and the actions of orientating, aligning and inserting do not allow materially different alternative methods. The burden is on the examiner to provide reasonable examples that recite material differences. MPEP § 806.05(e). The apparatus cannot be assembled by a method *materially* different than that of the process claims, and furthermore, no examples of alternative assembly processes were provided by the Examiner. Therefore Inventions I and II are not distinct.

2. Comments Regarding Inventions I and III related as subcombinations

The Examiner has asserted that Inventions I and III are distinct based on alleged relationship as subcombinations disclosed as usable together in a single combination under MPEP § 806.05(d). [Office Action p. 2]. Invention I and Invention III are not related as subcombinations but rather as combination and subcombination respectively. A combination is

an organization of which a subcombination or element is a part. MPEP § 806.05(a). Invention I is a combination because it is an organization of the elements comprising recessed structural beams, vertical posts, and shelf members, as set forth in independent claims 1, 8 and 15.

Invention III is a subcombination of Invention I, because Invention III is the recessed structural beams which are an expressly required element of Invention I. Without the recessed structural beams, the framework of Invention I could not be used for storage. If the framework of Invention I did not have the recessed structural beams, the shelving members could not be horizontally positioned in the framework, and the framework would not be able to store materials on top of the shelving members. Therefore, Invention I and Invention III are not related as subcombinations; but rather, Invention I is a combination and Invention III is a subcombination.

Consequently, in order to establish that the combination and subcombination are distinct, two-way distinctiveness must be demonstrated. MPEP § 806.05(c). The Examiner states that the Invention III beams have separate utility such as use in the assembly of a building [Office Action p.2]. However, two-way distinctiveness is required in addition to separate utility for a proper restriction requirement between combination and subcombination. MPEP § 806.05(c). Therefore, for the inventions to be distinct, the elements of the subcombination must not be required for patentability of the combination as claimed. *Id.*

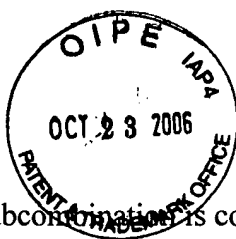
Here the features of the subcombination represented by Invention III are required for the patentability of the combination represented by Invention I. The recessed structural beams in Invention I, as represented by independent claims 1 and 8, and the recessed structural beams of Invention III, as represented by independent claims 22-25 and 28, include identical features of recessed flanges at the top and return flanges at the base. The recessed structural beams in

Invention I, as represented by independent claim 15, and the recessed structural beams of Invention III, as represented by independent claims 26, 27 and 29, include identical features of angled flanges at the top and bottom. In addition to the flanges, the other features of the beams of Invention III reside in the dependent Invention I claims if not required by the independent Invention I claims. For example, the beam fingers of Invention III claims 22, 24 and 26 are also required in Invention I claims 2, 3, 9, 10, 16 and 17; the apertures of Invention III claims 23, 25 and 27 are also required in Invention I claims 5, 6, 9, 12, 13, 19 and 20. Therefore, Invention I and Invention III are not distinct.

3. Rebuttal of Serious Burden

The fact that some inventions are classified by the USPTO in separate classes does not of itself warrant the requirement of a restriction. *Ex parte Uhlig*, 1903 C.D. 300 (Comm'r). The Examiner has only cited different subclasses of class 211 as evidence of acquiring separate status, which does not of itself warrant the requirement of a restriction. There is no indication that the subclasses 187 and 189 are special subclasses.

Additionally, even if Inventions I, II and III are distinct, the examiner must show by appropriate explanation a separate status in the art when they are classified together. MPEP § 808.02. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search. *Id.* The Examiner has not cited any patents which are evidence of such separate status and that a separate field of search is required. To the contrary, the patent No. 5,749,481 cited in applicant's IDS indicates that several subclasses under class 211 were allowable as a single invention. The Examiner has not shown that the subcombination of Invention I represented by Invention III has acquired an independent status in the art.



A subcombination is considered a search burden when the subcombination is broadly recited and the specific characteristics required by the subcombination claims are not required by the combination claims. MPEP § 806.05(c). As discussed above, such is not the case here, where the beam characteristics required by the claims of subcombination Invention III are shared by the claims of combination Invention I. Therefore, subcombinations represented by Invention III would be regarded as being so related to the general combination represented by Invention I as to entitle Inventions I and III to be claimed in the same application.

4. Express Election

Applicant traverses Examiner's restriction requirements of Inventions I, II and III and makes an express provisional election of Invention III, represented by claims 22-29, for prosecution as required by 37 CFR 1.143. Applicant further preserves the right to file a divisional application on non-elected claims under 35 USC § 121.

5. Conclusion

Applicant respectfully traverses the restriction requirement and makes an express election, as required by 37 CFR 1.143.

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